

BEST AVAILABLE COPY

Response Under 37 CFR 1.116
Expedited Procedure
Examining Group 3739RemarksRECEIVED
CENTRAL FAX CENTER

OCT 05 2006

Claim Rejections under 35 USC 112

Claims 32-38 are rejected as being indefinite for failing to particularly point out the subject matter which Applicant regards as the invention.

In telephone discussions with Applicant's attorney, the Examiner asked whether the claim language is broader than the essence of the invention. The current claim language is NOT broader than the essence of the invention.

The apparatus claimed in Claim 27 as well as the catheter described in Claim 32, are supported by the description of the invention as set forth in Figs. 1, 2, 3 and 4.

Claim Rejections under 35 USC 101

Claims 32-38 are rejected because the claimed invention is directed to non-statutory subject matter, that is, the claims recite both an apparatus and a method of making the apparatus.

Applicant's attorney discussed this issue with the Examiner, pointing out that product-by-process claims are acceptable, and the Examiner concurred. The Examiner stated that once the 101 rejections are overcome (which he accepted had been done in the discussion), he would cite 35 USC 102 and/or 35 USC 103 rejections based on the previously cited prior art.

Applicant responds regarding such prior art rejections as follows.

The electrolyte treating of the mapping electrodes generates electrodes with a reduced number of electrical interference centers, in comparison with un-treated electrodes. The effect of the electrolyte treating is shown, in particular, in Figs. 8, 9, 14 and 15 of the application. These Figures show differences in the micro-structure of the surface of the electrodes. This modified surface structure reduces disturbing interference fields.

Muntermann (H)02MUN0018USP 10/049,934
Response to Office Action of 05/11/2006 submitted by Fax with certification on 10/5/2006

6

BEST AVAILABLE COPY

Response Under 37 CFR 1.116
Expedited Procedure
Examining Group 3739

Accordingly, an electrode treated with a method according to the invention is new and inventive in comparison to the state of the art, and in relation to the previously cited prior art.

Allowable Claims

Claims 10-25 and 27 are allowed. Given the above comments, Applicant respectfully believes that claims 32-38 should now also be allowable.

Previously presented Claim 32, a multiple dependent claim depending from allowable Claims 10-25, recites: "a catheter for the ablation of biological tissue, in particular animal or human tissue, including ablation of human myocardial tissue, said catheter comprising at least one ablation or mapping electrode, producible, in particular being produced with a method according to one of claims 10 to 25".

Since the catheter is produced with a method according to one of the allowable claims 10 to 25, the product by process claim 32 should be allowable. In particular, a catheter produced according to the subject matter of one of the claims 10 to 25 has a reduced number of electrical interference centres.

Dependent claims 34 to 38 relate to further features of the catheter, as previously set forth in now cancelled claims 1 to 9.

Accordingly, the subject matter of the product claim 32 and dependent claims are new and inventive. Therefore, the claims should overcome the "103" rejections.

Applicant respectfully believes that the claims, as amended, are now all allowable.

BEST AVAILABLE COPY

Response Under 37 CFR 1.116
Expedited Procedure
Examining Group 3739

PTO 2038 is included herewith authorizing charging a credit card for the prescribed small entity two month extension fee of \$225.

Wherefore, further consideration and allowance of the claims, as amended, is respectfully requested.


Respectfully submitted,



M. Robert Kestenbaum
Reg. No. 20,430
11011 Bermuda Dunes NE
Albuquerque, NM USA 87111
Telephone (505) 323-0771
Facsimile (505) 323-0865

CERTIFICATE OF SUBMISSION BY FACSIMILE TRANSMISSION

I hereby certify under 37 CFR §1.8(a) that this correspondence is being submitted to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 by facsimile transmission on October 5, 2006, fax number (571) 273 8300.



M. Robert Kestenbaum